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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,194	10/20/2003	Triveni P. Shukla	00030-001	4436

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EXAMINER
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TRAN LIEN, THUY

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/689,194

Applicant(s)

SHUKLA ET AL.

Examiner

Lien T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/26/05, 2/2/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

The amendment filed 2/26/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The insertions on page 2 line 30 stating " The dietary fiber gels are produced by shearing agricultural by-products, such as seed brans, hulls, and so forth, under alkaline conditions. Dietary fiber gels in a hydrated form can exist as gel and in the dehydrated form as flakes or powders. " The smoother morphology is readily revealed under electron microscopic magnification of dietary fiber gel. Without being bound by any specific theory, it is believed that the smooth morphology reflects an amorphous nature of the insoluble compounds that constitute dietary fiber gel. The insertions starting on page 2 line 30 to before the paragraph which starts on page 3 line 68.

In the response filed 2/26/05, applicant states the insertions are supported by US Patent no. 5766622 and application 10/669731 which were incorporated by reference. This statement is not accurate because the original specification did not incorporate by reference the patent and the application. A mere referral to the patent and application is not an incorporation of the patent and the application in the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention,

Applicant claims cookies and cookie dough comprising an emulsified liquid shortening composition; the composition comprises dietary fiber gel. The gel is an essential element to the composition; however, the specification does not teach how to form the gel or how the gel is mixed with water and lipid to form the emulsified liquid shortening composition. How much water and lipid are needed? What kind of lipid can be used? There is no disclosure of how the gel is made and how the shortening composition is made. There is disclosure of what cookie formulation or dough to use. One skilled in the art would not know how to make the composition and cookie from reading the specification.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al in view of Stone

Young et al disclose a bakery shortening substitute. The shortening substitute may be an oil-in-water emulsion or water-in-oil emulsion. The emulsion comprises water, konjac gel and lipid. The shortening can replace shortening and other conventional fats in bakery food formulations on a one-to-one volume basis. The shortening substitute is used in cookies. ( see col. 3 lines 7-13, col. 9 lines 19-39, col. 11 lines 1-31)

Young et al do not disclose the amount of solid delivered by the fiber gel.

Stone teaches konjac is a soluble dietary fiber. (col. 2 line 28)

While Young et al do not use the term dietary fiber gel, the konjac gel is a dietary fiber gel because konjac is a soluble dietary fiber as shown by Stone. As to the amount, Young et al teach the shortening substitute can replace the fat in conventional

formulations on a one-to-one basis; thus, the amount of solid in the fiber gel can vary depending on the cookie formulation and the amount of fat present in such formulation. It would have been obvious to one skilled in the art to use any known cookie formulation depending on the taste, flavor and texture desired.

The Leitz et al reference is removed because the claims no longer contain the limitation "insoluble dietary fiber".

In the response filed 2/26/05, applicant states the claims are fully enabled by the specification as amended. However, the amendment to the specification is objected to because the insertions requested introduce new matter into the specification and are not a part of the original disclosure. The original disclosure does not teach one skilled in the art how to make the claimed invention.

With respect to the 103 rejection, applicant states Young et al teach shortening substitutes that comprise a gelatin phase and a lipid phase wherein the gelatin phase comprises water and soluble gelling agent, konjac. Applicant argues the shortening is different from the claimed shortening comprising dispersible insoluble dietary fiber, water and lipid. This argument is not persuasive because it is not commensurate in scope with the claims. The claims do not recite anything about the fiber being insoluble fiber. It is not clear what applicant means by dispersible; the claims do not recite anything about the fiber being dispersible. The claims recite a shortening composition comprising dietary fiber gel, water and lipid. This composition is disclosed in Young et al. The claims do not have any limitation on how the fiber gel, the composition are made; thus, any argument based on such limitations are not relevant to the issue in the

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application. The language "comprising" of the claims does not exclude other components taught by Young et al. Applicant argues the references lack any suggestion to combine. The rejection is not based on combination of reference in the sense of modifying the primary disclosure by incorporating the teaching of the secondary reference. Since Young et al do not specifically disclose the term dietary fiber, the Stone reference is simply used to show that konjac is a fiber material and thus, the gel in Young et al is a fiber gel even though such terminology is not used. The Leitz et al reference is no longer used in the rejection because applicant removes the limitation "wherein the dietary fiber gel comprises insoluble dietary fiber" from the claims.

Applicant's arguments filed 2/26/05 have been fully considered but they are not persuasive.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien T. Tran whose telephone number is 571-272-1408. The examiner can normally be reached on Tuesday, Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cano Milton can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 10, 2006

*Lien Tran*  
LIEN TRAN  
PRIMARY EXAMINER  
*Group 1700*